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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT SEAMANS
APPELLANT

Appeal 2008-3316
Application 10/602,416
Application Publication 2004/0231190
Technology Center 3700

Decided: October 21, 2008

Before RICHARD TORCZON, SALLY GARDNER LANE, and JAMES T.
MOORE, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

The appeal is from a Final Rejection of claims 1, 9, 12-16, 18-27, and 40-42, which are all of the pending claims. 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

The application was filed January June 23, 2003. The real party in interest is Crocs, Inc. (App. Br. 2).

The Examiner relied on the following references.

| <u>Name</u> | <u>Number</u> | <u>Date</u> |
|-------------|---------------|---------------|
| Albiniano | 2,897,566 | Aug. 4, 1959 |
| Seidel | 4,476,600 | Oct. 16, 1984 |
| Lamstein | Des. 416,667 | Nov. 23, 1999 |
| Aguerre | 6,237,249 | May 29, 2001 |

The Examiner also relied upon “admitted prior art at page 11 of the instant specification.” We understand the “admitted prior art” to be EP 0 802 039 (“EP ‘039”), published Oct. 22, 1997. Appellant did not argue against the prior art status of these references.

Appellant appeals the rejection of claims 1, 9, 12-16, 18-23, 26-27, and 40-42 under 35 U.S.C. § 103(a) over Aguerre, Seidel, Albiniano, and EP ‘039. Appellant argued separately for the patentability of claim 42. (*See* App. Br. 5). We therefore review claims 1 and 42. *See* Bd. R. 41.37(c)(1)(vii).

Appellant also appeals the rejection of claims 24 and 25 under 35 U.S.C. § 103(a) over Aguerre, Seidel, Albiniano, and EP ‘039, and Lamstein. We also therefore review claims 24 and 25.

II. LEGAL PRINCIPLES

The Supreme Court has recently noted that “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007). Furthermore, citing *United States v. Adams*, 383 U.S. 39 (1966), the

Court reemphasized that “when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* In making a rejection for obviousness, the Court noted that “[a]s our precedents make clear . . . the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741.

III. FINDINGS OF FACT AND ANALYSIS

The record supports the following findings of fact as well as any other findings of fact set forth in this opinion, by at least a preponderance of the evidence.

Claims 1, 9, 12-16, 18-23, 26, 27, and 40-42

Facts

1. Appellant’s claim 1 recites:

A sectional footwear piece comprising:
a base section, wherein the base section includes an upper and a sole having an outer portion of a rear sole perimeter, formed as a first part molded from a first continuous piece of lofted foam material; and
a strap section having an inner portion, wherein the strap section is formed as a second part molded from a second continuous piece of said lofted foam material, and wherein the strap section is attached to the base section such that the strap contacts the base section and pivots relative to the base section; and wherein a frictional force between the strap section and the base section at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section.

(App. Br., Claims Appx., 11).

2. Appellant's claim 42 recites:

A sectional footwear piece, the sectional footwear piece comprising:

a base section, wherein the base section includes an upper and a sole having an outer portion of a rear sole perimeter, formed as a first part molded from a first continuous piece of lofted foam material;

a strap section having an inner portion, wherein the strap section is formed as a second part molded from a second continuous piece of said lofted foam material, and wherein the strap section is attached to the base section such that the strap contacts and pivots relative to the base section;

wherein the strap section is attached to the base section by a first and a second rivet made of plastic that is denser than the lofted foam material, wherein the first rivet fastens a first end of a strap as section to a first side of the base section, and wherein the second rivet fastens to a second end of the strap section to a second side of the base section;

wherein a frictional force between the strap section and the base section at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section; and

wherein the first rivet is placed at a first attachment point, wherein the second rivet is placed at a second attachment point, wherein the base section includes a upper opening perimeter, wherein the base section includes a rear sole perimeter, wherein the distance from the first attachment point to the second attachment point along the upper opening perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section; and wherein the distance from the first attachment point to the second attachment point along the rear sole perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section.

(App. Br., Claims Appx., 14-15).

3. Figure 1 of Appellant's specification is reproduced below.

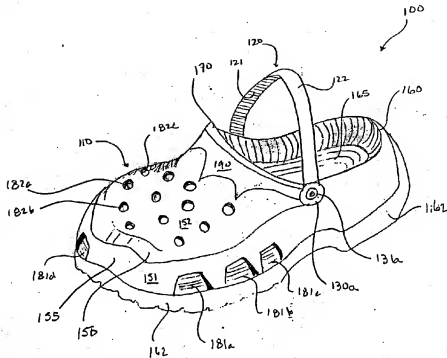


Figure 1 depicts “a footwear piece 100 in accordance with some embodiments of the present invention,” including a base section 110, with an upper 150, a sole 162, and a rear sole perimeter 160, a strap section 120, and rivets 131. (Spec. ¶¶ [0026], [0031], and [0032]).

4. Figure 11 of Appellant's specification is reproduced below.

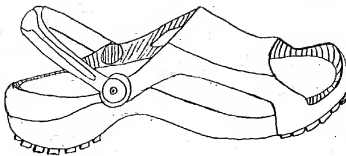


Figure 11 depicts “yet another footwear piece . . . in accordance with some embodiments of the present invention.” (Spec. ¶ [0041]).

5. Aguerre relates to a “convertible slide type sandal typically worn as footwear in the out-of-doors during the warm months of the year [and] used indoors as well as at the beach or the swimming pool.” (Aguerre col. 2, ll. 21-24).

6. Figure 1 of Aguerre is reproduced below.

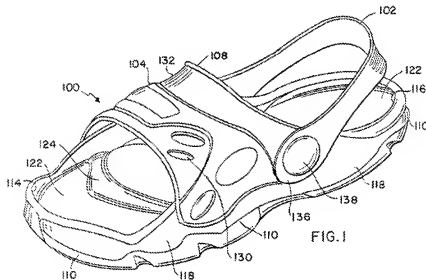


Figure 1 depicts a slide with an upper vamp 104, a midsole 110, “a rearward section that curls upward in the heel area and is known as a heel bumper 116” (Aguerre col. 4, ll. 55-57), and a rear heel strap 102. (See Aguerre col. 4, ll. 27-60).

7. The convertible slide of Aguerre has a base section and a strap section, as recited in Appellant’s claims 1 and 42.

8. The base section taught by Aguerre has an upper and a sole as recited in Appellant’s claims 1 and 42.

9. The midsole 110 of the slide in Aguerre “typically is comprised of ethylene vinyl acetate (i.e. ‘EVA’).” (Aguerre col. 5, ll. 63-64).

10. Aguerre does not specifically teach that the upper vamp and outsole are “molded from a continuous piece of lofted foam material,” as claimed.

11. Aguerre teaches that “[i]n the lowered position, the rear heel strap 102 fits snugly behind the heel to secure the convertible side 100 to the human foot.” (Aguerre col. 4, ll. 34-36).

12. Aguerre teaches that the sandal also includes “outwardly extending studs 106 which serve as pivot points to facilitate use of the convertible slide 100 with or without the rear heel strap 102, all without disassembling the sandal.” (Aguerre col. 4, ll. 31-34).

13. Aguerre teaches that the “[t]he components of the convertible slide are comprised of rubber and manmade synthetic cushioning materials.” (Aguerre col. 2, ll. 32-33).

14. Figure 2 of Aguerre is reproduced below.

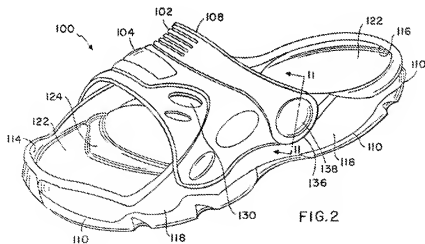


Figure 2 depicts the convertible slide of Figure 1 “showing the rear heel strap in the rotated raised position and resting forward of the contoured lip on the rear side of the vamp.” (Aguerre col. 3, ll. 41-43).

15. Comparison of Figure 1 and Figure 2 of Aguerre reveals that the distance from the first attachment point [138] to the second attachment point [not pictured in Figure 1 or 2 of Aguerre] along the upper opening perimeter [of the vamp 104] is approximately the same distance from the first attachment point to the second attachment point along the strap section [102]; and wherein the distance from the first attachment point to the second attachment point along the rear sole perimeter [116] is approximately the same distance from the first attachment point to the second attachment point along the strap section [102],

as recited in Appellant’s claim 42.

16. The convertible slide of Aguerre demonstrates the dimensions recited in Appellant’s claim 42, wherein

the distance from the first attachment point to the second attachment point along the upper opening perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section; and wherein the distance from the first attachment point to the second attachment point along the rear sole perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section.

(See FF 2).

17. Aguerre teaches that “[t]he rear heel strap of the inventive convertible slide is elastic or other flexible material to facilitate attaching the sandal to the foot.” (Aguerre col. 2, ll. 37-39).

18. Aguerre does not specifically teach that the rear heel strap is “molded from a continuous piece of lofted foam material,” as claimed.

19. Aguerre does not specifically teach that the rear heel strap is “molded from a continuous piece of lofted foam material,” as claimed.

20. In “alternative” embodiments (*see* Aguerre col. 8, ll. 36-37, and col. 9, ll. 35-36), Aguerre provides washer separators or a threaded screw to prevent friction between the rear heel strap 102 and the vamp 104. (*Id.* at col. 9, ll. 20-29, and col. 10, ll. 42-48).

21. Seidel relates to shoes made entirely from plastic, which “are more particularly used for special purposes, for example as beach, bathing and sports shoes and the like, but also are available as standard working or walking shoes.” (Seidel col. 1, ll. 16-20).

22. Seidel teaches

a one-piece, washable and sterilizable plastic shoe made from an elastic and robust and preferably expanded plastic material, comprising a lower part with a top on which bears the foot and a bottom enveloping an outsole and a heel which is optionally offset therefrom, as well as an upper part extending onto the lower part, forming a cavity for receiving the toes, ball and metatarsus and having ventilating openings, characterized in that ventilating openings are provided in the substantially vertical lateral area of the upper part of the shoe spaced from one another over the outsole edge and the outer boundary edges thereof are lower than the corresponding inner boundary edges.

(Seidel col. 2, ll. 35-48).

23. Appellant’s specification notes that “[m]anufacturing footwear pieces using . . . a lofted foam material can include providing a resin that includes a pre-mixture of resin, pigment, and a growth additive” (Spec. ¶ [0042]), and that “[i]n one particular embodiment, the resin is Ethylene Vinyl Acetate copolymer (EVA) based material.” (*Id.* ¶ [0046]).

24. Appellant's specification notes: "Additional disclosure of such cross-linking and expansion [for ethylene vinyl acetate copolymer ("EVA")] is provided in European Patent 0 802 039 A2, filed on March 25, 1997" (Spec. ¶ [0046]).

25. European Patent Application EP 0 802 039 A2 ("EP '039") was published Oct. 22, 1997, and is entitled: "Injection moulding method for EVA-soles, having a treading surface with coloured sections." (Spec. ¶¶ [0046]-[0047]).

26. EP '039 teaches that "expansible and cross-linking 'EVA', thanks above all to its low cost, is widely used in the footwear sector for production of inexpensive injection moulded soles." (EP '039 col. 1, ll. 23-26).

27. Albiniano relates to an attachment of a strap to a shoe, "which is economical to manufacture and assemble on the shoe." (Albiniano col. 1, ll. 24-26).

28. Figure 1 of Albiniano is reproduced below.

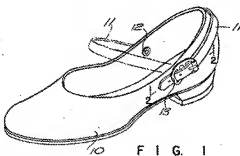


Figure 1 depicts a "shoe 10 having a strap 11 attached to one side of the shoe by a rivet 12 which permits the strap 11 to be swiveled into the dotted line position shown" (Albiniano col. 1, ll. 56-58).

29. The strap depicted in Figure 1 of Albiniano is shown in two positions, which are held by frictional force in relation to the sole.

Analysis

The Examiner rejected claims 1, 9, 12-16, 18-23, 26, 27, and 40-42 under 35 U.S.C. § 103(a), over Aguerre, Seidel, and Albiniano, as well as prior art the Examiner asserted was admitted in Appellant's specification. Aguerre discloses a convertible slide that has a base section and a strap section. (FF 3). Seidel teaches a shoe made entirely from one piece of "expanded plastic material." (FF 22). Albiniano teaches a swivel strap for a shoe (FF 28), "which is economical to manufacture and assemble on the shoe" (FF 27). The skilled artisan would have had reason to substitute this strap for the rear heel strap of Aguerre, which is similarly anchored by a stud or rivet (FF 12).

Appellant's specification notes that cross-linking and expansion agents for the copolymer EVA are provided in EP '039 (FF 26), which was available prior art to Appellant's filing date (see FF 25). EP '039 teaches that "expandable and cross-linking 'EVA', thanks above all to its low cost, is widely used in the footwear sector for production of inexpensive injection moulded soles." (FF 26). EP '039 teaches that EVA can be used for the treading on shoe soles. (FF 25). As noted in Appellant's specification, EVA produces "lofted foam material." (FF 23). Aguerre teaches that the convertible slide it discloses can be made of "rubber and manmade synthetic cushioning materials" (FF 13), with a midsole made of EVA (FF 9). Thus, those of skill in the art would have had a reasonable expectation of success in using this lofted foam material for the midsole and outer soles of a footwear piece. The low cost would have been reason to do so.

The Appellant first argues on appeal that the Examiner erred in finding the claimed subject matter *prima facie* obvious because none of the cited art teaches “that the strap section is formed as a second continuous piece of lofted foam material.” (App. Br. 6). The Appellant argues further that “Aguerre teaches away from making a base section ‘formed as a first part molded from a first continuous piece of lofted foam material’ by disclosing a sandal that is constructed of discrete pieces of multiple materials.” (Reply Br. 3). According to Appellant, “the examiner has provided no evidence (in support of a motivation to combine) that making a heel strap of such a material would be ‘easier and cheaper.’” (App. Br. 7).

We find the Appellant’s arguments unpersuasive because it is the combination of Aguerre and Seidel, along with EP ‘039 and Albiniano that renders the claimed footwear piece obvious, not each reference separately. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”). Aguerre teaches a convertible slide with a rear heel strap (FF 6), which can be used at the beach or swimming pool (FF 5), while Seidel teaches a one-piece plastic shoe that is washable (FF 22) and is also useful for beach and bath (FF 21). To achieve both advantages of attachment to the foot (FF 17) and a washable shoe (FF 22), those of skill in the art would have had reason to combine Aguerre and Seidel, making a one-piece convertible slide, with a strap. Because EP ‘039 teaches a low cost material for making shoes, which is a lofted foam (FFs 23 and 26), those in the art would have recognized that a one-piece shoe could be made

cheaply with this material. Thus, the combination of the references renders the claimed footwear obvious.

Though the Appellant argues that Aguerre “teaches away” from using a continuous piece of lofted foam material, he has not directed us to a specific disclosure in Aguerre, or any other reference, that would have discouraged those in the art from making a slide out of a single piece of material. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”). We are not convinced that those of skill in the art would not have combined Seidel, which teaches advantages of using a single piece of material (FF 22), with the convertible slide taught in Aguerre. Furthermore, we are not convinced that those of skill in the art would not have used the lofted foam material taught in EP ‘039 (*see* FF 23) to make this footwear piece, considering its low cost (FF 26).

The Appellant also argues that “Aguerre fails to teach a molded, lofted foam heel strap configured such that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section.” (App. Br. 8). Appellant recognizes that the Examiner cited Albiniano for this feature of the claims, but argues that this was error because “Aguerre specifically teaches the benefits of being freely rotated and uses washers to accomplish this. Hence, one of skill in the art would have no motivation to substitute it [sic] washers for the connectors described in Albiniano. (App. Br. 8). Furthermore, Appellant argues that “[b]ecause

the heel strap of Aguerre is designed to freely rotate about its connection point, and to specifically minimize friction to ensure free rotation through use of, *e.g.*, washer separators, it may not be properly combined with Albiniano.” (App. Br. 8).

This argument is also not persuasive of error. Aguerre provides alternative embodiments which reduce friction between the rear heel strap and vamp; however, these solutions are only alternative embodiments. (FF 20). Appellant has not explained how the presence of these alternative embodiments would have discouraged those in the art from using the swivel type attachment of Albiniano, “which is economical to manufacture and assemble on the shoe.” (FF 27). *See Gurley, supra*.

In regard to claim 42, Appellant argues that the Examiner erred in finding the subject matter of the claims to have been obvious in that:

Aguerre fails to specifically disclose that the distance from the first attachment point to the second attachment point along the upper opening perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section, or that the distance from the first attachment point to the second attachment point along the rear sole perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section.

(App. Br. 8-9).

We disagree. Comparison of Figures 1 and 2 of Aguerre demonstrate this claim element. (FFs 6, 14, and 15).

In addition, Appellant argues that

Aguerre fails to specifically disclose that the strap section can pivot relative to the base section such that an inner portion of

the strap section contacts an outer portion of the rear sole perimeter.

(App. Br. 9).

Again, we disagree. One of ordinary skill in the art would recognize that if the rear heel strap 102 of Aguerre Figure 1 is rotated fully, the strap fits snugly around the wearer's heel (FF 6) and so reaches the outer portion of the sole perimeter, where the wearer's heel sits.

The Examiner presented a prima facie case for the obviousness of the footwear of Appellant's claims 1 and 42. Appellant has not persuaded us that this prima facie case is incorrect and has not directed us to evidence of secondary considerations that rebut this prima facie case. Accordingly, the Examiner did not err in rejecting claims 1 and 42 under 35 U.S.C. § 103 over Aguerre, Seidel, Albiniano, and the prior art referred to in Appellant's specification.

Claims 24 and 25

Facts

30. Appellant's claim 24 recites:

The sectional footwear piece of claim 1, wherein the sole comprises a support base, and wherein the support base includes a raised pattern extending throughout the surface where a foot contacts the support base.

(App. Br., Claims Appx., 13).

31. Appellant's claim 25 recites:

The sectional footwear piece of claim 1, wherein the sole comprises a bottom surface and a support base, and wherein the support base includes a raised pattern extending throughout the surface where a foot contacts the support base and further comprising a tread on the sole.

(App. Br., Claims Appx. , 13).

32. Lamstein teaches a design for a molded plastic shoe. (Lamstein at title).

33. Figures 1 and 2 of Lamstein are reproduced below.

FIG. 1

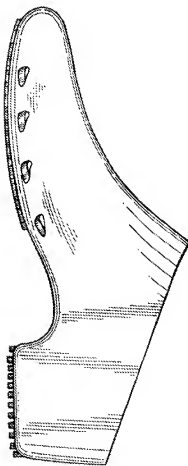


FIG. 2

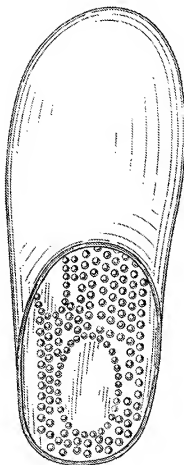


Figure 1 depicts an outside view of a shoe with a raised pattern on the outside bottom surface and Figure 2 depicts an inside view of a shoe with a raised pattern on the interior surface.

Analysis

The Examiner rejected claims 24 and 25 under 35 U.S.C. § 103(a) over Aguerre, Seidel, Albiniano, EP '039, and Lamstein.

Lamstein discloses a design for a molded plastic shoe (FF 29) with a raised pattern on both the surface of the support base and on the bottom surface, as a tread. (FF 30).

The Appellant argues that the Examiner erred in concluding that the subject matter of claims 24 and 25 would have been obvious to one of ordinary skill in the art because:

Lamstein fails to teach or suggest this limitation and instead teaches away from it. Lamstein teaches a method in which a raised pattern does not extend throughout the surface of a support base. *See* Fig. 2. In fact, the support base does not have a raised pattern in the sections where a human foot would come into the greatest amount of contact with it. *See id.*

(App. Br. 10). In support, Appellant notes that Lamstein provides “a smooth surface where the heel contacts the shoe base.” (Reply Br. 5).

However, we find that the pictures provided in Lamstein depict a raised pattern that extends over almost the entire viewable surface inside the support base. (FF 33). Consequently, we conclude that the Examiner did not err when concluding that those in the art would have found it obvious to substitute the partial raised surface depicted by Lamstein with a complete raised surface, as claimed, to provide more traction for the foot. *See KSR*, 127 S.Ct. at 1740 (“when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.”). Appellant has not explained why the specific design depicted in

Lamstein would have discouraged those in the art from extending the raised pattern to cover all surfaces contacted by the foot.

Consequently, Appellant has not convinced us the Examiner erred in rejecting claims 24 and 25 under 35 U.S.C. § 103 over Aguerre, Seidel, Albiniano, Lamstein, and the prior art referred to in Appellant's specification.

IV. ORDER

Upon consideration of the record and for the reasons given, the Examiner's rejection of claims 1, 9, 12-16, 18-23, 26, 27, and 40-42 under 35 U.S.C. § 103(a), over Aguerre, Seidel, Albiniano, and EP '039, is AFFIRMED; and

the Examiner's rejection of claims 24 and 25 under 35 U.S.C. § 103(a) over Aguerre, Seidel, Albiniano, EP '039, and Lamstein is AFFIRMED.

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Appeal 2008-3316
Application 10/602,416

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